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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,256	06/23/2003	William B. Kerfoot	10578-009002	1911
26161	7590	01/11/2005		
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			EXAMINER HOEY, BETSEY MORRISON	
			ART UNIT	PAPER NUMBER
			1724	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,256

Applicant(s)

KERFOOT, WILLIAM B.

Examiner

Betsey M Hoey

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-17, 19-22 and 31-33 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 18, 23-30 and 34-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/23/03 & 11/24/03</u> | 6) <input type="checkbox"/> Other: _____ |

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1. From MPEP §2114:

**APPARATUS CLAIMS MUST BE STRUCTU-RALLY DISTINGUISHABLE
FROM THE PRIOR ART**

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function...."[A]pparatus claims cover what a device is, not what a device does."

Therefore, claims 18, 23-30 and 34-37 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 18, 23-30 and 34-37 fail to further limit the *structure* of the apparatus of claim 11 or claim 15.

2. Claim 13 is objected to because it is written as a method claim, although it is dependent on an apparatus claim. It is suggested that the claim be rewritten to recite the apparatus of claim 1 wherein the microporous diffuser comprises a central inner chamber and an outer chamber. Appropriate correction is required.

3. Claims 11-17, 19-22 and 31-33 are allowed.

4. The following is a statement of reasons for the indication of allowable subject matter:

5. Claims 11-14 and 20-22 are allowed (with amendment to claim 13; see above) because the prior art of record fails to teach, disclose, or fairly suggest an apparatus for treating subsurface water comprising a source of select liquid hydroperoxides and a feed mechanism to deliver selected liquid hydroperoxides to a microporous diffuser, in combination with the other limitations of instant claim 11.

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Claims 15-17, 19 and 31-33 are allowed because the prior art of record fails to teach, disclose, or fairly suggest an apparatus for treating subsurface water comprising a microporous diffuser, an air compressor that feeds a mixture of air/ozone into the diffuser, and a feed mechanism to supply a liquid decontamination agent containing hydroperoxide to the diffuser, in combination with the other limitations of claim 15.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betsey Hoey whose telephone number is **(571) 272-1158**. The examiner can normally be reached on Mondays, Tuesdays, and Thursdays. The examiner's supervisor, Mr. Duane Smith, may be reached at (571) 272-1166. Any inquiry of general nature may be directed to the Group receptionist at (571) 272-0987. The centralized fax number for the Group is (703) 872-9306. The examiner Rightfax number is (571) 273-1158.



BETSEY MORRISON HOEY
PRIMARY EXAMINER

January 10, 2005